The indication on page 12 of the Official Action that the Examiner would be willing to reconsider the 35 USC 103 rejections of record upon the submission of a declaration has been noted with appreciation. Applicants submit herewith a Declaration under 37 CFR 1.132 executed by one of the inventors, Toshiyuki Miyabayashi, which shows the unexpectedly advantageous results that can be achieved with the claimed ink composition comprising, in addition to the recited polymer emulsion, both the recited solid wetting agent and the recited penetrating agent. In particular, the declaration shows that the claimed ink composition, comprising both the recited solid wetting agent and the recited penetrating agent, (a) performs better in the evaluations for print quality, print density and fast drying than a corresponding ink composition (Ink I) that does not contain the penetrating agent, and (b) performs better in the evaluations for anti-clogging, ejection stability and storage stability than a corresponding ink composition (Ink II) that does not contain the solid wetting agent. (Note: the evaluation criteria are described in the specification at page 60, line 1 to page 63, line 5.)

Certain claims stand rejected under 35 USC 102(e) as allegedly being anticipated by Ota et al. Applicants respectfully traverse this rejection.

As discussed in Applicants' Amendment dated August 22, 2005 in the paragraph bridging pages 9-10, the cited reference does not show a single ink composition as claimed comprising **both** the recited penetrating agent and the recited solid wetting agent. Rather, the reference describes a vast number of possible wetting agents for use in the process described therein. Indeed, the list of possible wetting agents is **not** restricted (see paragraph [0089]: "As

the wetting agent to be used in the invention, there may be used any wetting agent **without any restriction** so far as it has an effect of enhancing the dispersion efficiency as methioned above." (Emphasis added); see, also, paragraph [0107]). Moreover, **even among the wetting agents listed** in the reference, one must pick and choose from a huge number of possible combinations to arrive at the claimed combination; this without any motivation in the reference to make the necessary selection.

The Examiner has referred to MPEP 2131.02(A) for the proposition that "when the species is clearly named, the species claim is anticipated no matter how many other species are additionally named". However, Applicants respectfully note that the provisions of MPEP 2131.02(A) make clear that this proposition is applicable only in the case where the prior art describes a species that falls within a claimed genus. The proposition is inapposite in a situation where, as here, a **species** is claimed comprising a **combination** of components and the reference does **not** name the combination. Indeed, rather than describing a species falling within a claimed genus, the reference describes a vast number of individual components without any suggestion to select the recited components from among them for use in the claimed combination.

Under these circumstances, it is respectfully submitted that the claimed combination of components cannot be considered to be anticipated by the reference. See, e.g., *In re Meyer,* 599 F.2d 1026, 202 USPQ 175 (CCPA 1979) (A reference disclosing "alkaline chlorine or bromine solution" embraces a large number of species and cannot be said to anticipate claims to

"alkali metal hypochlorite."); *Akzo N.V. v. International Trade Comm'n*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986) (Claims to a process for making aramid fibers using a 98% solution of sulfuric acid were not anticipated by a reference which disclosed using sulfuric acid solution but which did not disclose using a 98% concentrated sulfuric acid solution.).

The claims have also been rejected under 35 USC 103(a) as allegedly being unpatentable over the references cited at paragraphs 5-8 of the Official Action. Applicants respectfully traverse these rejections.

In each of these rejections, the Examiner has recognized that the cited primary references do not show the combined use in an ink composition as claimed of the recited wetting agent and penetrating agent. The Examiner nevertheless contends that there would have been a motivation to incorporate into the ink compositions of the primary reference a wetting agent described in the secondary reference, Kubota et al, to arrive at the claimed invention. Even assuming *arguendo* that this were true, Applicants respectfully submit that the evidence in the declaration submitted herewith is sufficient to rebut any alleged *prima facie* case of obviousness set forth by the cited references.

As discussed above, the declaration submitted herewith shows that the claimed ink composition, comprising both the recited penetrating agent and the recited wetting agent, performs better in print quality, print density and fast drying than an ink containing only the recited wetting agent, and performs better in anti-clogging, ejection stability and storage stability

than an ink containing only the recited penetrating agent. There is nothing in the cited references that would show or suggest these advantages whereby the advantages must be considered to be unexpected. On this basis, Applicants respectfully submit that the evidence of record rebuts any alleged *prima facie* case of obviousness for the claimed combination.

In view of the above, it is respectfully submitted that all rejections and objections of record have been overcome and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,

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